



30 APR 2003

Alan C. Rose  
Oppenheimer Wolff & Donnelly LLP  
2029 Century Park East, 38th Floor  
Los Angeles, CA 90067-3024

In re Application of  
AKHAVE et al.  
U.S. Application No. 09/647,752  
PCT No.: PCT/US98/25875  
Int. Filing Date: 07 December 1998  
Priority Date: 08 December 1997  
Attorney Docket No.: 310048-347-US  
For: CONTROLLED DROPLET FORMED  
LAYERED STRUCTURES

## DECISION ON PETITION

This decision is in response to applicants' "Renewed Petition under 37 CFR 1.137(b)" which is being treated as a Renewed Petition under 37 CFR 1.137(b) and Renewed Petition under 37 CFR 1.47(a) filed 16 April 2003 to accept the application without the signature of joint inventor, Ghanshyam H. Popat. Applicants' "Petition for Late Acceptance of Declaration or in the Alternative to Revive Based on Unintentional Abandonment of Application," filed 31 May 2002 was dismissed in a decision dated 23 July 2002.

The above-captioned national stage application became abandoned on 05 February 2001 for failure to submit an acceptable oath or declaration within the time period set forth in the "Notification of Missing Requirements under 35 U.S.C. 371 in the United States Designated/Elected Office (DO/EO/US)" (Form PCT/DO/EO/905) mailed 04 January 2001.

**BACKGROUND**

On 07 December 1998 applicants filed international application PCT/US98/25875 which claimed a priority date of 08 December 1997. A Demand was filed with the International Preliminary Examination Authority prior to the 19th month from the earliest claimed priority date. As a result, the deadline for payment of the basic national fee was to expire 30 months from the priority date, or at midnight on 08 June 2000.

On 04 October 2000, applicants filed a transmittal letter requesting entry into the national stage in the United States, which was accompanied, inter alia, by: the basic national fee; a copy of the international application; an information disclosure statement; and a petition seeking revival under 37 CFR 1.137(b). The petition to revive under 37 CFR 1.137(b) was granted in a decision dated 21 December 2000.

On 04 January 2001, the United States Designated/Elected Office mailed a Notification of Missing Requirements under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497(a) and (b) must be filed. The notification set a one-month time limit in which to respond.

On 31 May 2002, applicants filed a petition under 37 CFR 1.137(b) and 37 CFR 1.47(a). The petitions were dismissed in a Decision dated 23 July 2002.

On 16 April 2003, applicants filed the present petition under 37 CFR 1.137(b) and 37 CFR 1.47(a).

### DISCUSSION

The above-identified application was abandoned on 05 February 2001 for failure to respond to the Notification of Missing Requirements mailed 04 January 2001.

Under 37 CFR 1.137(b), a petition requesting that an application be revived on the grounds of unintentional delay must be accompanied by: (1) the required reply, (2) the petition fee required by law, (3) a statement that the "entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unintentional," and (4) any terminal disclaimer and fee required pursuant to 37 CFR 1.137(c). Applicants have satisfied Items (2)-(4).

In order to comply with the proper response requirement of item (1) above for revival under 37 CFR 1.137(b), applicants submitted the present Petition Under 37 CFR 1.47(a). Under the present circumstances, in order for the response requirement, item (1) above, to be satisfied, the petition to accept the application without the signature of joint-inventor Ghanshyam H. Popat must be grantable.

A petition under 37 CFR 1.47(a) must be accompanied by (1) the fee under 37 CFR 1.17(h), (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and behalf of the non-signing joint inventor. Applicant has provided items (1), (3) and (4) under 37 CFR 1.47(a).

Regarding item (2) above, Section 409.03(d) of the Manual of Patent Examining Procedure (M.P.E.P.), **Proof of Unavailability or Refusal**, states, in part:

Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

Proof that a bona fide attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature, but the inventor refused to accept delivery of the papers or expressly stated that the application papers should not be sent, may be sufficient.

When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the statement of facts. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the statement of facts. The document may be redacted to remove material not related to the inventor's reasons for refusal.

When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in the statement of facts in support of the petition or directly in the petition. If there is documentary evidence to support facts alleged in the petition or in any statement of facts, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the petition.

A review of the present petition reveals that applicants have not satisfied the item (2) above, in that the applicants have not shown that a bona fide attempt was made to present the application papers, including the specification, claims, and drawings to Ghanshyam H. Popat. The declaration of Sharon Brady states, "I sent a Declaration to Inventor Popat on February 7, 2003 to his last known address . . . via Federal Express with a letter instructing him to execute the Declaration . . ." The mailing of the Declaration is not considered a complete copy of the application papers (specification, including claims, drawings, and oath and declaration). Additionally, declarant states that the papers were mailed to Mr. Popat via Federal Express, however, no documentary evidence has been provided regarding this mailing. As stated above, in order to meet the requirements of 37 CFR 1.47(a) and Section 409.03(d) of the MPEP, a statement of facts is needed from a person having first hand knowledge of the facts that a complete copy of the application papers was sent to Ghanshyam H. Popat, and when such papers were sent. In addition, copies of documentary evidence such as a certified mail return receipt, cover letter of instruction, telegrams, etc., should be supplied with the declaration.

For the reasons stated above, it would not be appropriate to accept the application without the signature of Ghanshyam H. Popat under 37 CFR 1.47(a) at this time.

Therefore, the petition to revive under 37 CFR 1.137(b) cannot be granted at this time.

### CONCLUSION

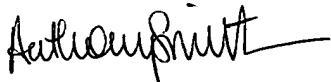
The petition under 37 CFR 1.137(b) is DISMISSED without prejudice.

The petition under 37 CFR 1.47(a) is DISMISSED without prejudice.

The application remains ABANDONED.

If reconsideration on the merits of this petition is desired, an appropriate response to this decision must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.137(b)." Extensions of time may be obtained under 37 CFR 1.136(a).

Applicant is advised that, effective May 1, 2003, the Office is changing its correspondence address. Any further correspondence with respect to this matter deposited with the United States Postal Service on or after May 1, 2003 should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



Anthony Smith  
Attorney-Advisor  
Office of PCT Legal Administration  
Tel.: 703-308-6314  
Facsimile: 703-308-6459